



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,118	08/08/2003	Brian Dorricott	28489/39573	3822
4743	7590	02/28/2007	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			CHEEMA, UMAR	
			ART UNIT	PAPER NUMBER
			2109	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/28/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

B7C

Office Action Summary	Application No.	Applicant(s)	
	10/637,118	DORRICOTT, BRIAN	
	Examiner	Art Unit	
	Umar Cheema	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 August 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-22 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 August 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>November 24, 2003</u> . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on November 24, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

4. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Software, per se:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

"[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

EXAMPLES:

1. A computer program product for . . .

6. **Claim 22** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux et al (US 6,782,003) in view of Greenspan et al (US 6,850,484).

10. Regarding **claim 1**, Giroux et al teach a method of transferring users' email accounts (col. 5, lines 14-16) from a source server to a destination server (abstract), the method comprising:

setting up the destination server to act as a gateway transferring e-mail connections to the source server; and transferring users' mail folders from the source server to the destination server (fig. 4b(450), col. 6, lines 57-63).

Giroux et al **do not teach setting up destination server to act as a gateway** in their disclosure.

11. However in the same field of endeavor Greenspan et al teach the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (abstract).

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Giroux et al teaching and Greenspan et al teaching for transferring email accounts from source server to destination server where destination server acts as a gateway. It is true because gateway is a common protocol used for a software or hardware communications.

13. Regarding **claim 2**, Greenspan et al teach a method as claimed in claim 1, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

14. Regarding **claim 3**, Giroux et al teach a method as claimed in claim 2, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).

15. Regarding **claim 4-5**, the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 1, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 4, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).

16. Regarding **claim 6**, Giroux et al teach a method as claimed in claim 1, wherein setting up the destination server comprises setting up the destination server to initiate the transfer of the user's mail folder and its contents (col. 9, lines 50-54) from the source server to the destination server when each user logs on for the first time (col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

17. Regarding **claim 7**, Greenspan et al teach a method as claimed in claim 6, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

18. Regarding **claim 8**, Giroux et al teach a method as claimed in claim 7, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).

19. Regarding **claim 9-10**, the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 6, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 9, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).

20. Regarding **claim 11**, Giroux et al teach a method as claimed in claim 6, further comprising initiating the transfer of the user's mail folder when each user logs on for the first time before the destination server services the user (col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

21. Regarding **claim 12**, Greenspan et al teach a method as claimed in claim 11, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

Art Unit: 2109

22. Regarding **claim 13**, Giroux et al teach a method as claimed in claim 12, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).

23. Regarding **claim 14-15**, the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 11, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 14, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).

24. Regarding **claim 16**, Giroux et al teach a method as claimed in claim 6, further comprising: causing the destination server to pass the e-mail connection through to the source server when each user logs on for the first time; and transferring the user's mail folder once the user has logged off (col. 6, lines 47-62, fig. 5(500), col. 5, lines 54-60).

25. Regarding **claim 17**, Greenspan et al a method as claimed in claim 16, wherein setting up the destination server comprises allocating the destination server the same IP address as the source server (col. 2, lines 60-67, col. 3, lines 1-5), the method further comprising allocating the source server a new IP address (col. 3, lines 5-10).

26. Regarding **claim 18**, Giroux et al teach a method as claimed in claim 17, further comprising retiring the source server once all e-mail accounts have been transferred (fig. 4a, col. 6, lines 12-15).
27. Regarding **claim 19-20**, the combination of Giroux et al and Greenspan et al teach a method as claimed in claim 16, further comprising routing mail connections to users' e-mail accounts via the destination server with a router (Greenspan: abstract, col. 3, lines 55-60); and a method as claimed in claim 19, further comprising retiring the source server once all e-mail accounts have been transferred (Giroux: fig. 4a, col. 6, lines 12-15).
28. **Claims 21-22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Giroux et al (US 6,782,003) in view of Greenspan et al (US 6,850,484).
29. Regarding **claim 21**, Giroux et al teach an apparatus for transferring users' e-mail accounts (col. 5, lines 14-16) from a source server to a destination server (abstract), the apparatus comprising:
a source server on which is set up the e-mail accounts (col. 3, lines 30-35); and a destination server arranged to receive e-mail accounts as they are transferred from the source server (abstract, col. 3, lines 30-35), arranged as a gateway transferring e-mail connections to the source server, and further arranged to initiate transfer of users' mail folders as they each log in (col. 6, lines 47-62).

Giroux et al do not teach gateway transferring e-mail connections in their disclosure.

30. However in the same field of invention Greenspan et al teach a system manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers, and the stream manager is linked to a packet network, such as the internet (abstract).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Giroux et al teaching and Greenspan et al teaching for transferring e-mail accounts. It is true because gateway is a common protocol to use for a software and hardware communication.

31. Regarding **claim 22** Giroux et al teach a computer program product (col. 7, Software Architecture) for transferring users' e-mail accounts from a source server to a destination server, the computer program product comprising a computer readable program code configured to cause the destination server to act as a gateway transferring e-mail connections to the source server (abstract, fig. 4a-b, col. 7, lines 10-13), and further configured to transfer users' e-mail folders from the source server to the destination server (abstract, col. 5, lines 14-16, fig 4a-b).

Giroux et al do not teach destination server to act as a gateway in their disclosure.

Art Unit: 2109

32. However in the same field of endeavor Greenspan et al teach the stream manager that can include a computer based router or server that behaves as if it were a gateway for a sub-network of destination site servers (abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Giroux et al teaching and Greenspan et al teaching for a computer program product for transferring email accounts from source server to destination server where the computer program product comprising a computer readable program code configured to cause destination server acts as a gateway transferring e-mail connections to the source server. It is true because gateway is a common protocol used in any software or hardware communications.

Conclusion

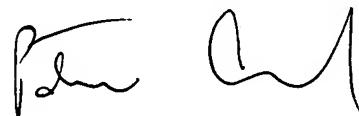
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Waskiewicz (US 5,822,526) teaches system and method for maintaining and administering email address names in a network. Earl et al. (US 2003/0208511 A1) teach database replication system. Chung et al. (US 7,136,901) teach an electronic mail server which provides email communication over a network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Umar Cheema whose telephone number is 571-270-3037. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Assouad can be reached on 571-272-2210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

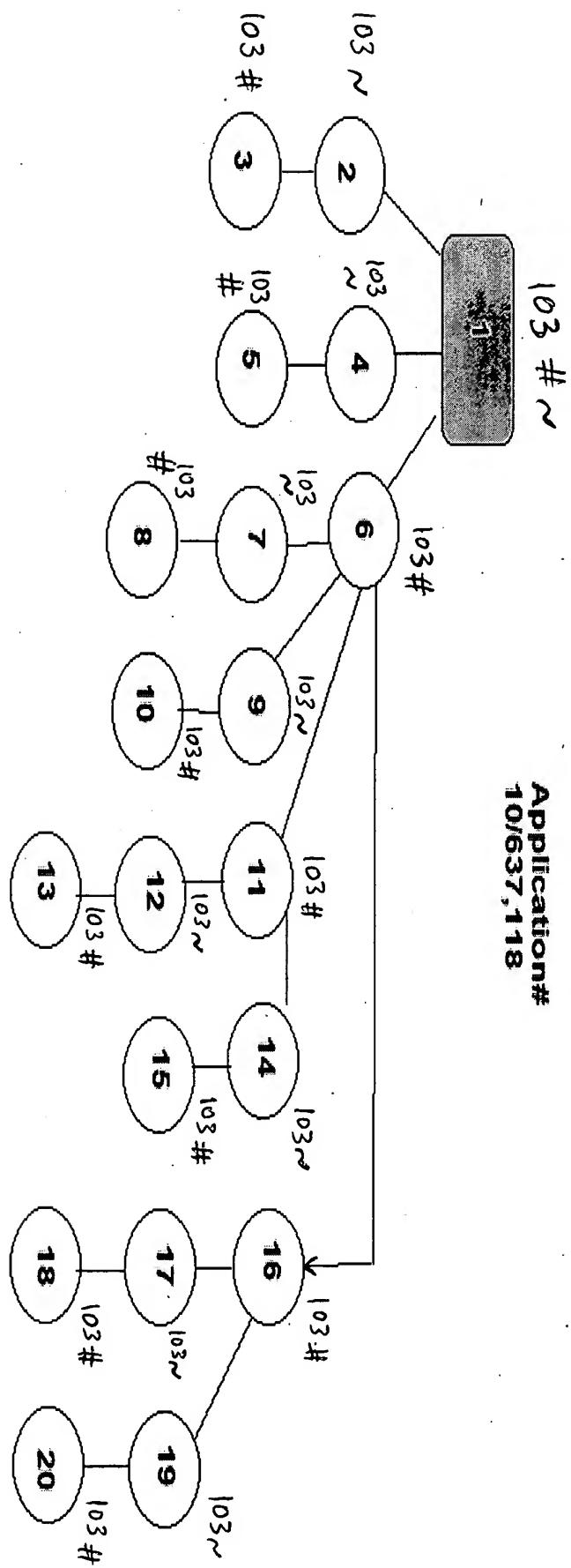
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

uc



PATRICK ASSOUAD
SUPERVISORY PATENT EXAMINER

Application#
10/637,118



103 #~

103 #~

21

22

Giroux et al. #
Greenspan et al. ~